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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 0687/72242-AB/JPW/GJG

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on November 22, 2006

Signature: Gary J. Gershik

Typed or printed name: Gary J. Gershik

Application Number	Filed
09/981,124	October 17, 2001

First Named Inventor: Allan Green et al.

Art Unit	Examiner
1638	E. McElwain

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [X] attorney or agent of record. Registration number 39,992
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Gary J. Gershik
Signature

Gary J. Gershik
Typed or printed name

212-278-0400
Telephone number

November 22, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of _____ forms are submitted.

Docket No. 72242-AB/JPW/GJG

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Allan Green et al.

Serial No.: 09/981,124 Examiner: E. McElwain

Filed : October 17, 2001 Group Art Unit: 1638

For : FATTY ACID EPOXYGENASE GENES FROM PLANTS AND USES THEREFOR IN MODIFYING FATTY ACID METABOLISM

1185 Avenue of the Americas
New York, New York 10036
November 22, 2006

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to a July 12, 2005 Notice in the Official Gazette, applicants respectfully request that a panel of Examiners review the final rejection of the above-identified application which was set forth in a September 31, 2006 Final Office Action.

This Request is being filing concurrently with a Notice of Appeal in a separate paper.

1. The rejection of pending claims 26-29 and 31-43 under 35 U.S.C. § 112, first paragraph, as allegedly not enabled has been maintained in the September 31, 2006 Final Office Action. Claims 26-29 and 31-40 are directed to transgenic plants that have been exemplified in the subject application. See, Examples in the subject application. Claims 41-43 are drawn to a process for making the transgenic plants, which process is also exemplified in the Examples of the subject application.

2. The specification provides a teaching of how to make and use the claimed transgenic plants. Specifically, to make a

transgenic plant in accordance with the pending claims, the specification teaches which genes should be inserted into a plant. The specification also teaches, and the pending claims recite, the conserved amino acid sequences which the genes should encode. See, e.g. page 48, lines 1-10 of Example 3. Indeed, applicants' disclosure has been the basis for subsequent work in which transgenic plants, other than those exemplified in the subject application but within the scope of the pending claims, have successfully been made. See, applicants' January 5, 2006 Amendment, particularly pages 14-21, and the references cited therein showing such transgenic plants being made consistent with applicants' teaching.

3. The September 31, 2006 Final Office Action, however, has refused to acknowledge that the subject application enables any transgenic plant other than the exemplified plants. The refusal is justified by only four conclusory sentences on page 5 of the September 31, 2006 Final Office Action. No basis in fact is provided in the October 31, 2006 Final Office Action which directly rebuts applicants' position set forth on pages 14-21 of their January 31, 2006 Amendment.

4. In conclusion, Applicants respectfully submit that the October 31, 2006 Final Office Action fails to set forth a reasoned basis founded on evidence contradicting applicants' teaching of how to make and use the claimed invention. Applicants' teaching must therefore be found to enable the claimed invention. See, e.g. *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988); *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff'd. sub nom., Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985); *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971);

Scott v. Finney, 34 F.3d 1058, 1063, 32 USPQ2d 1115, 1120 (Fed. Cir. 1994); *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995); and M.P.E.P. § 2164.04.

No fee is deemed necessary in connection with the filing of this Pre-Appeal Brief Request For Review. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

/Gary J. Gershik/

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/Gary J. Gershik/ 11/22/06
Gary J. Gershik Date
Reg. No. 39,992